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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,295	10/28/2003	Lawrence Morrisroe	694231/0051 JJD:IGD	5110

7590 08/18/2004

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EXAMINER


YOUNG, JOHN L

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 08/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/696,295	Applicant(s) MORRISROE ET AL.	
	Examiner John L Young	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2003.  
 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1-30 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

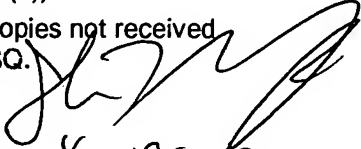
- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

JOHN LEONARD YOUNG, ESQ.  
 PRIMARY EXAMINER

  
 8-13-2004

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **NON-FINAL REJECTION**

### **DRAWINGS**

1. This application has been filed with drawings that are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

### **CLAIM REJECTIONS - 35 U.S.C. §101**

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

2. Claims 1-6, 11-14, 16, 22-23 & 25-26 are rejected under 35 U.S.C. 101, because said claim is directed to non-statutory subject matter.

Claims 1-6, 11-14, 16, 22-23 & 25-26, as drafted are not limited by language within the technological arts (see *In re Waldbaum*, 173 USPQ 430

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(CCPA 1972); *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172 (CCPA 1974) also see MPEP 2106 IV 2(b) even though said claims are limited by language to a useful, concrete and tangible application (See *State Street v. Signature financial Group*, 149 F.3d at 1374-75 , 47 USPQ 2d at 1602 (Fed Cir. 1998) ; *AT&T Corp. v. Excel*, 50 USPQ 2d 1447, 1452 (Fed. Cir. 1999).

Note: it is well settled in the law that "[although] a claim should be interpreted in light of the specification disclosure, it is generally considered improper to read limitations contained in the specification into the claims. See *In re Prater*, 415, F.2d 1393, 162 USPQ 541 (CCPA 1969) and *In re Winkhaus*, 527 F.2d 637, 188 USPQ 129 (CCPA 1975), which discuss the premise that one cannot rely on the specification to impart limitations to the claims that are not recited in the claims." (See MPEP 2173.05( q )).

### **CLAIM REJECTIONS — 35 U.S.C. §103(a)**

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences

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between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-30 are rejected under 35 U.S.C. §103(a) as being unpatentable over Inoue US 2003/0208560; class 709/219 (11/06/2003) [US f/d: 03/19/2001] (herein referred to as "Inoue").

As per claim 1, Inoue (FIG. 1; FIG. 2; FIG. 3; FIG. 5B; FIG. 6A; FIG. 13; ¶¶[0039]; [0077]; [0078]; [0081]; [0082]; [0083]; [0086]; [0088]; [0093]; [0096]; [0097]; [0108]; and [0116] shows a master file and advertisement tracking data; ¶¶[0084]; [0123] shows an input file; ¶[0092] shows "*advertisement data is stored in an advertisement file. . . .*" ¶¶[0095]; [0164]; [0167] shows "*advertisement data . . . are stored in a transmission data file. . . .*" ¶¶[0100]; [0101] shows an "*advertisement information file. . . .*" ¶¶[0102]; [0104]; [0105] shows "*an advertisement data file. . . .*"; ¶[0140]; and FIG. 16; FIG. 17; and FIG. 18; shows "*Upon reception of the input data contents from the advertisement-provider computer . . . the server computer . . . newly creates and adds the record in the advertisement master file . . . based on the received data. . . .*" ¶[0202] shows "*The server computer . . . adds the data contents of the files.*

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...”). The Examiner interprets these disclosures as showing: “A method for providing an ad, the method comprising: combining an ad input file with a conduit file to create an integrated ad file, wherein the ad input file identifies the content of the ad and the conduit file identifies tracking data for the ad; and serving the integrated ad file, thereby providing the ad.”

Inoue lacks explicit disclosure of “combining an ad input file with a conduit file to create an integrated ad file. . . .” even though the disclosure of Inoue as cited above implicitly shows same.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Inoue (FIG. 1; FIG. 2; FIG. 3; ¶¶[0039]; [0077]; [0078]; [0081]; [0082]; [0083]; [0086]; [0088]; [0093]; [0096]; [0097]; [0108]; [0116]; [0084]; [0123]; [0092]; [0095]; [0164]; [0167]; [0100]; [0101]; [0102]; [0104]; [0105]; and [0140] implicitly shows “combining an ad input file with a conduit file to create an integrated ad file. . . .”, because modification and interpretation of the cited disclosure of Inoue would have provided “*an advertisement distribution system which selects only useful advertisements corresponding to store attributes of a target store and transmits the selected advertisements to the store. . . .*” (see Inoue (¶[0008])) based on the motivation to modify Inoue so as to “[select] advertisement contents which are suitable or ad-user attributes, and for distributing the advertisement contents data and its

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*corresponding advertisement attribute information through a computer communications network.” (See Inoue (the ABSTRACT)).*

As per claims 2-10, Inoue shows the method of claim 1 and subsequent base claims depending from 1.

Inoue (FIG. 1; FIG. 2; FIG. 3; ¶¶[0039]; [0077]; [0078]; [0081]; [0082]; [0083]; [0086]; [0088]; [0093]; [0096]; [0097]; [0108]; [0116]; [0084]; [0123]; [0092]; [0095]; [0164]; [0167]; [0100]; [0101]; [0102]; [0104]; [0105]; and [0140]; and whole document) implicitly shows the elements and limitations of claims 2-10.

Inoue lacks explicit recitation of some elements of claims 2-10, even though Inoue cited above implicitly shows same.

Official Notice is taken that both the concept and the advantages of the elements and limitations of claims 2-10 were well known and expected in the art at the time of the invention. It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Inoue (FIG. 1; FIG. 2; FIG. 3; ¶¶[0039]; [0077]; [0078]; [0081]; [0082]; [0083]; [0086]; [0088]; [0093]; [0096]; [0097]; [0108]; [0116]; [0084]; [0123]; [0092]; [0095]; [0164]; [0167]; [0100]; [0101]; [0102]; [0104]; [0105]; and [0140]; and whole document) implicitly shows all of the elements and limitations of claims 2-10, because modification and

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interpretation of the cited disclosure of Inoue would have provided “*an advertisement distribution system which selects only useful advertisements corresponding to store attributes of a target store and transmits the selected advertisements to the store. . . .*” (see Inoue (§[0008])), based on the motivation to modify Inoue so as to “[*select*] advertisement contents which are suitable or ad-user attributes, and for distributing the advertisement contents data and its corresponding advertisement attribute information through a computer communications network.” (See Inoue (the ABSTRACT)).

Independent claim 11 is rejected for substantially the same reasons as independent claim 1.

As per claims 12-15, Inoue shows the method of claim 11 and subsequent base claims depending from 11.

Inoue (FIG. 1; FIG. 2; FIG. 3; ¶¶[0039]; [0077]; [0078]; [0081]; [0082]; [0083]; [0086]; [0088]; [0093]; [0096]; [0097]; [0108]; [0116]; [0084]; [0123]; [0092]; [0095]; [0164]; [0167]; [0100]; [0101]; [0102]; [0104]; [0105]; and [0140]; and whole document) implicitly shows the elements and limitations of claims 12-15.

Inoue lacks explicit recitation of some elements of claims 12-15, even



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though Inoue cited above implicitly shows same.

Official Notice is taken that both the concept and the advantages of the elements and limitations of claims 12-15 were well known and expected in the art at the time of the invention. It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Inoue (FIG. 1; FIG. 2; FIG. 3; ¶¶[0039]; [0077]; [0078]; [0081]; [0082]; [0083]; [0086]; [0088]; [0093]; [0096]; [0097]; [0108]; [0116]; [0084]; [0123]; [0092]; [0095]; [0164]; [0167]; [0100]; [0101]; [0102]; [0104]; [0105]; and [0140]; and whole document) implicitly shows the elements and limitations of claims 12-15, because modification and interpretation of the cited disclosure of Inoue would have provided “*an advertisement distribution system which selects only useful advertisements corresponding to store attributes of a target store and transmits the selected advertisements to the store. . . .*” (see Inoue (¶[0008])), based on the motivation to modify Inoue so as to “[*select*] advertisement contents which are suitable or ad-user attributes, and for distributing the advertisement contents data and its corresponding advertisement attribute information through a computer communications network.” (See Inoue (the ABSTRACT)).

Independent claim 16 is rejected for substantially the same reasons as

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independent claim 11.

As per claims 17-23, Inoue shows the method of claim 16 and subsequent base claims depending from 16.

Inoue (FIG. 1; FIG. 2; FIG. 3; ¶¶[0039]; [0077]; [0078]; [0081]; [0082]; [0083]; [0086]; [0088]; [0093]; [0096]; [0097]; [0108]; [0116]; [0084]; [0123]; [0092]; [0095]; [0164]; [0167]; [0100]; [0101]; [0102]; [0104]; [0105]; and [0140]; and whole document) implicitly shows the elements and limitations of claims 17-23.

Inoue lacks explicit recitation of some elements of claims 17-23, even though Inoue cited above implicitly shows same.

Official Notice is taken that both the concept and the advantages of the elements and limitations of claims 17-23 were well known and expected in the art at the time of the invention. It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Inoue (FIG. 1; FIG. 2; FIG. 3; ¶¶[0039]; [0077]; [0078]; [0081]; [0082]; [0083]; [0086]; [0088]; [0093]; [0096]; [0097]; [0108]; [0116]; [0084]; [0123]; [0092]; [0095]; [0164]; [0167]; [0100]; [0101]; [0102]; [0104]; [0105]; and [0140]; and whole document) implicitly shows the elements and limitations of claims 17-23, because modification and interpretation of the cited disclosure of Inoue would have provided “an

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*advertisement distribution system which selects only useful advertisements corresponding to store attributes of a target store and transmits the selected advertisements to the store. . . .” (see Inoue (¶[0008])), based on the motivation to modify Inoue so as to “[select] advertisement contents which are suitable or ad-user attributes, and for distributing the advertisement contents data and its corresponding advertisement attribute information through a computer communications network.” (See Inoue (the ABSTRACT)).*

Independent claim 24 is rejected for substantially the same reasons as independent claim 11.

As per claims 25-30, Inoue shows the medium of claim 24 and subsequent base claims depending from 24.

Inoue (FIG. 1; FIG. 2; FIG. 3; ¶¶[0039]; [0077]; [0078]; [0081]; [0082]; [0083]; [0086]; [0088]; [0093]; [0096]; [0097]; [0108]; [0116]; [0084]; [0123]; [0092]; [0095]; [0164]; [0167]; [0100]; [0101]; [0102]; [0104]; [0105]; and [0140]; and whole document) implicitly shows the elements and limitations of claims 25-30.

Inoue lacks explicit recitation of some elements of claims 25-30, even though Inoue cited above implicitly shows same.

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Official Notice is taken that both the concept and the advantages of the elements and limitations of claims 25-30 were well known and expected in the art at the time of the invention. It would have been obvious at the time the invention was made to a person having ordinary skill in the art that the disclosure of Inoue (FIG. 1; FIG. 2; FIG. 3; ¶¶[0039]; [0077]; [0078]; [0081]; [0082]; [0083]; [0086]; [0088]; [0093]; [0096]; [0097]; [0108]; [0116]; [0084]; [0123]; [0092]; [0095]; [0164]; [0167]; [0100]; [0101]; [0102]; [0104]; [0105]; and [0140]; and whole document) implicitly shows the elements and limitations of claims 25-30, because modification and interpretation of the cited disclosure of Inoue would have provided “*an advertisement distribution system which selects only useful advertisements corresponding to store attributes of a target store and transmits the selected advertisements to the store. . . .*” (see Inoue (¶[0008])), based on the motivation to modify Inoue so as to “[*select*] advertisement contents which are suitable or ad-user attributes, and for distributing the advertisement contents data and its corresponding advertisement attribute information through a computer communications network.” (See Inoue (the ABSTRACT)).

## CONCLUSION

4. Any response to this action should be mailed to:

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Any response to this action may be sent via facsimile to either:

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(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is

(703) 305-3900.

John L. Young

Primary Patent Examiner

JOHN LEONARD YOUNG, ESQ.  
PRIMARY EXAMINER

August 13, 2004